rejection under 35 U.S.C. 103(a) of the other invention. In the instant case then there could have been no patentability of all the claims over Pieper et al. CA 122.

Paper No. 5 at page 2; emphasis added.

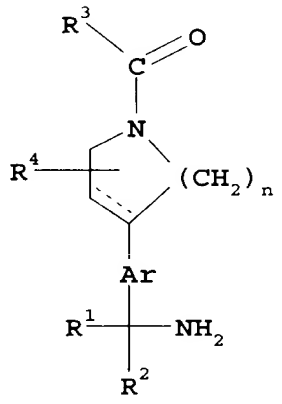
Applicants respectfully traverse the Restriction Requirement.

Applicants submit that the Restriction Requirement as the Examiner has not provided any comment regarding how the inventions I, II and IV are independent **and** distinct as required by 35 USC § 121 or 37 CFR § 1.141.

Applicants also submit that the present claims 1-54 (encompassing groups I and II) are directed to compounds encompassed in Markush form and such are only properly subject to restriction pursuant to MPEP 803.02. Specifically, MPEP 803.02 states that "...the examiner must examine all the members of the Markush group in the claim on the merits, even though they are directed to independent and distinct inventions." In the instant case, Applicants submit that the Examiner should adhere to the requirement of MPEP 803.02 as the Examiner has provided no reasoning why this section is not applicable in the instant caase.

More specifically, Applicants submit that a compound claimed in Markush form is proper and not subject to a Restriction Requirement where "the claims ... cover compounds all belonging to a genus ... [having] a community of properties justifying their grouping which was not repugnant to principles of scientific classification." *In re Harnisch*, 206 USPQ 300, 305. Furthermore, a compound claimed in Markush form should not be subject to a Restriction Requirement as the compounds encompassed by a generic formula "must be considered as wholes and not broken down into elements or other components." *In re Harnisch*, 206 USPQ 300, 305. Thus, Applicants submit also that the Examiner has no foundation for dissecting Applicants' compounds and relying on differences in elements, bonding arrangements and chemical properties in the compounds of group I and group II to make the RestrictionRequirement. *Ex Parte Holt and Randell*, 214 USPQ 381, 386, also describes that it is improper to dissect the molecule into core and pendant substituents and then conclude that variable cores inherently constitute an improper Markush group, i.e., to support a Restriction Requirement.

Furthermore, Applicants submit that the compounds of their invention have the requisite community of properties justifying their grouping, i.e., they are useful as tryptase inhibitors. Applicants submit that the grouping of the compounds of the invention do in fact share a common structural core or nucleus in the generic compound having the below formula.



Furthermore, such core as claimed by Applicants is not repugnant to principles of scientific classification. The only variability in the core is that the nitrogen-containing ring thereof can have from 5 to 8 members and optionally contains a double bond. Such variability in portions of a core are supported by Ex parte Dahlen et al. wherein the core in the compound thereof had a ring system containing a variable Y consisting of twelve members. In view of the aforesaid, Applicants submit that their genus meets the requirements of *In re Harnisch* and obviates the Restriction Requirement.

Applicants note that the Examiner has stated that method claims of group 55-63 can be prosecuted together with the election of a compound claim of Group I or II upon the election of a single disclosed condition/disease of claim 56 or 57.. Applicants submit that linking claim practice pursuant to MPEP 806.05(h) controls this matter.

Applicants note that they find no support for Group IV not also being considered if either Group I or II is elected. In particular, Applicants submit that Group IV is directed to a combination product that always contains as a constituent therein a compound of either Group I or II. Thus, if the compounds of either of Group I or II is elected and found to be patentability then surely any combination/composition containing those compounds and other active ingredients would also be patentable. Thus, Applicants submit that if Group I or II is elected then the claims of Group IV should also be prosecuted with that elected Group.

III. Provisional Election

To comply with the Examiner's Restriction requirement, Applicants provisionally elect, with traverse, Group II. Claims 1-2, 7-15, 18-21, 26, 30-31, 34, 36, 44-45, 48 and 50-54 are readable on Group I. The species elected pursuant to the Examiner's request in connection with Group I is 3-[1-(5-Phenylethynyl-furan-2-carbonyl)-piperidin-4-yl]-benzylamine trifluoroacetate, which

is the compound of Example 122 in the specification. In addition, the disease state elected pursuant to the Examiner's request is asthma.

Furthermore, Applicants affirm their right to file one or more divisional applications with respect to any of the non-elected subject matter.

Respectfully submitted,

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